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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/525,515	03/15/2000	Alan H. Karp	10992554-1	9501

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/525,515

Applicant(s)

KARP ET AL.

Examiner

Alain L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In view of the appeal filed on 1-28-04, PROSECUTION IS HEREBY REOPENED. The after final amendment filed 10-28-03 is hereby entered. A new rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 4-5, 7-8, 10, 12-13, 15-17, and 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 17, and 20 the recitation "compromise" is considered a relative term since what is considered compromise to one may not be considered compromise to another.

The term "counters" of claim 1, 4-5, 7-8, 10, 12-13, 15-16, and 20 is considered vague and indefinite. The term should be recited as "counteroffers".

The term "distributive attribute" in claim 9 is considered vague and indefinite since the meets and bounds are not clear in the context of a negotiation. Applicant's specification does not clearly distinguish between distributive and integrative attributes (page 11, line 19 onward of applicant's specification). It is unclear how to provide for a negotiation where there is no distributive attribute whatsoever.

In claim 10, the term "ultimatum" " is considered a relative term since what is considered an ultimatum to one may not be considered an ultimatum to another

In claim 15, the term "violation is considered a relative term since what is considered a violation to one may not be considered a violation to another.

In claim 16, the recitation of "introduces two or more disjunctions, each disjunction specifying different values for at least one attribute from the attribute-value pairs" is considered vague and indefinite. The description in applicant's specification

(page 10, lines 24 onward) does not clearly describe the word "disjunction". The word disjunction is defined as "two or more alternative terms, with the assertion that only one is true". From applicant's specification there appears to be a condition where more than one term is true concurrently. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term is indefinite because the specification does not clearly redefine the term.

Claims 1 and 20 recite "negotiation protocol" and a negotiation" which is vague and indefinite since it is not clear what statutory classes of invention this pertains to. Applicant must indicate on the record what statutory class of invention the claims belong to. For the purposes of this examination these claims are considered method.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-20 are rejected under 35 U.S.C. 101 as non-statutory because the method claims as presented do not claim a technological basis in the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the preamble and body of the claim structural / functional interrelationships that are solely by computer (and non-trivial) are considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-13, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bigus et al in view of Roderick.

Bigus et al discloses a buyers guide is disclosed wherein a product to be negotiated is (col 19, lines 1-20). The guide includes a set of attribute-value pairs, each

pair including an attribute and a range of values for the attribute (col 19, lines 8-10). An offer is present wherein a second negotiating party offers to negotiate one or more attributes for the product listed in the guide. One or more counter offers are present wherein the second and first negotiating parties continue to exchange counter offers until each attribute is agreed to (figs 5-6; col 9, lines 42-56).

The offer and counteroffers comprise succeeding proposed ranges of values including succeeding attributes that are included in the set of attribute-value pairs (col 3, lines 6-15; col 10, lines 26-35). Single values for each attribute are disclosed when agreement is reached. The range of values are reduced with each succeeding counteroffer (col 10, lines 62-67).

Bigus et al does not explicitly show the buyers guide as an “advertisement”, or the advertisement as listed by a first negotiating party.

Roderick discloses advertisements that may be part of a buyers guide (col 12, lines 36-55) and listings by a negotiating party (col 10, lines 55-66).

It would have been obvious to one with ordinary skill in the art to substitute and advertisement for the buyers guide of Bigus et al because Roderick teaches that advertisements may be a part of buyers guides.

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It would have been obvious to one with ordinary skill in the art to include the advertisement as listed by the first negotiating party because Roderick et al teaches advantages to advertising (col 1, lines 64-67; col 2, lines 1-28) and Bigus et al teaches value in gathering knowledge by negotiation agents (col 4, lines 35-40).

Bigus et al in view of Roderick further does not explicitly show:

- a) the recitation in claim 1: a look-up, wherein the product listed in the advertisement is located for a second negotiating party, wherein at least one of a first set of attribute-value pairs is displayed to the negotiating party;
- b) the entire recitation of claim 2;
- c) the entire recitation of claim 16;
- d) the recitation in claim 17: looking-up the product from the advertising step, wherein the looking-up step comprises:
 - displaying to a second negotiating party the set of attribute-value pairs; and
 - comparing one or more attribute-values provided by the second

negotiating party with the set of attribute-value pairs in the advertisement to find a match;

e) the recitation in claim 17: displaying to the second negotiating party the first negotiating party's proposal;

f) the recitation in claim 20: a look-up, wherein the plurality of attribute-value pairs is located for a second negotiating party by comparing one or more attribute-values provided by the second negotiating party with the plurality of attribute-value pairs in the advertisement;

g) the recitation of claim 20: a display to the second negotiating party of a first set of the plurality of attribute-value pairs of the advertisement;

h) the recitation of claim 20: a display to the second negotiating party of the second set of attribute-value pairs of the advertisement;

i) the recitation in claim 1, 17, and 20: with compromise.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re*

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Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowery, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art to include the above mentioned recitations, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentability distinguish the claimed invention.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bigus et al in view of Roderick as applied to claim 1 above, and further in view of Shkedy.

Bigus et al and Roderick do not explicitly disclose delivery as finalized.

Shkedy discloses delivery as finalized (col 5, lines 37-42).

It would have been obvious to one with ordinary skill in the art to include delivery as finalized because Shkedy teaches delivery considerations typical for commerce (col 5, lines 31).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bigus et al in view of Roderick as applied to claim 1 above, and further in view of Ausubel.

Bigus et al and Roderick do not explicitly disclose a declaration of a failed negotiation.

Ausubel discloses a declaration of a failed (stopped) negotiation is disclosed (col 30, lines 30-35).

It would have been obvious to one with ordinary skill in the art to include a declaration of a failed negotiation because Ausubel teaches bid problems that could lead to errors in auctions (col 30, lines 14-20).

Response to Arguments

10. Applicant's arguments with respect to claims of record have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-

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308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm
(Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alain L. Bashore